

REMARKS/ARGUMENTS

Claims 5 – 8 are currently pending in this application. Claims 1 – 4 were previously cancelled.

Telephonic Interview

The Examiner is thanked for granting a telephonic interview with the Applicants' representative on May 6, 2009. During the interview, the inventive features of the claims and the enclosed Declaration under §1.132 were discussed.

Claim Rejections - 35 USC §103(a)

Claims 5 – 8 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 2,084,079 to Clark in view of U.S. Patent No. 3,811,872 to Snape and the ASM Handbook.

Applicants respectfully traverse this rejection.

Claim 5 is directed to a method for producing an indexable insert fastening screw, having an interior engaging member. The method includes providing a source material of an ultra high-strength steel having a composition of 0.03% carbon, 5.0% molybdenum, 18.5% nickel, 8.5% cobalt, 0.6% titanium, 0.1% aluminum, and 77.27% iron. The method also includes cold forming the screw including the interior engaging member from the source material.

This is not shown by the combination of Clark and Snape. The examiner admits in the Action that Clark does not disclose the claimed alloy and cites *KSR* stating that it would have been “obvious to try.” The obvious to try reasoning applied in *KSR* is only appropriate if “**there are a finite number of identified, predictable solutions.**” As set forth in paragraph 4 of the enclosed Declaration of co-inventor Ernst Rohner under 37 C.F.R. §1.132, the development of the specific compound claimed for use in cold forming was the result of extensive research, trial and error. The properties of the steel varied in an **unpredictable** manner due to interactions between the individual components when the amounts were changed. Further, the extensive trial and error was required to find a composition able to provide a fissure free interior engaging member as is claimed.

Further, as set forth in paragraph 5 of the §1.132 Declaration, in the ASM Handbook, so-called maraging steels must first be annealed before they can be cold formed (worked). The claimed steel composition used in the claimed invention has been developed so that an annealing step prior to cold forming is not required. The composition is cold formed in its original state and only afterwards is it solution annealed and tempered thereby providing a higher strength.

Based on the arguments presented above and the Declaration under 37 CFR § 1.132 submitted herewith, withdrawal of the Section 103(a) rejection of claims 5 – 8 is respectfully requested.

Applicant: Mätzler et al.
Application No.: 10/535,694

Conclusion

If the Examiner believes that any additional minor formal matters need to be addressed in order to place the present application in condition for allowance, the Examiner is invited to contact the undersigned by telephone at the Examiner's convenience.

In view of the foregoing, applicants respectfully submit that the present application, including claims 5 - 8, is in condition for allowance, and a Notice to that effect is respectfully requested.

Respectfully submitted,

Mätzler et al.

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Enclosure